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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,769	01/19/2005	Hans Lichtenstein	264451US0PCT	4171
22850 7590 08/15/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER KOSLOW, CAROL M				
ART UNIT 1793		PAPER NUMBER		
NOTIFICATION DATE 08/15/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/521,769

Applicant(s)

LICHTENSTEIN ET AL.

Examiner

C. Melissa Koslow

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-7, 11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 6/27/08 (Two pages)
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

This action is in response to applicants' amendment of 27 June 2008 . The amendments to the claims have overcome the 35 USC 112 rejection over claim 2 and the rejections over canceled claims 10 and 12. Applicant's arguments with respect to the remaining rejection have been fully considered but they are not persuasive.

The citation of this application in the information disclosure statement of 27 June 2008 has been crossed off since the present case is not a related case.

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This claim is new matter since there is no teaching in the originally filed disclosure that the amount of dye and another colorant is 0.001-1 wt%. Page 3, lines 10-26 teaches the amount of the another colorant is 0.001-1 wt%, which indicates that amount of another colorant in the molding is 0.001-1 wt%. It is noted that the only teaching in the originally filed disclosure as to the amount of dye is in the examples and that amount is 0.05 wt% of the molding.

Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite since it depends from claim 1 and refers to "another colorant". There is no teaching of "another colorant" in claim 1. The "another colorant" is first claimed in claim 7. This it appears claim 15 should depend from claim 7, not claim 1. Claim 16 is indefinite

since it state the scattering agent is one or more material and includes mixtures thereof in the list of materials. Applicants should use either "one or more" or "mixtures thereof", not both.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 4-7, 11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06-67612.

The translation of this reference teaches a molding and signs including this molding which must be produced by incorporating the molding in a sign. The taught molding comprises a transparent plastic matrix, such as cast polymethyl methacrylate which has a transmittance in the claimed range, 0.001-1 wt% of a soluble fluorescent dye, 0.01-5 wt% of a color pigment and 0.01-10 wt% of a white pigment of a mixture of TiO₂ and barium sulfate. The weight ratio of TiO₂ to barium sulfate is greater than 0 wt% to less than 100 wt%. Thus the amount of TiO₂ is in the range of greater than 0 wt% to less than 10 wt%. The total amount of dye and color pigment is 0.011-5 wt% , which overlaps the claimed range. The compositional ranges overlap the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Since the taught composition overlaps the claimed composition, one of ordinary skill in the art would expect the taught molding to have a reflectance that overlaps the claimed range, absent any showing to the contrary. The reference suggests the claimed molding and method.

Applicants' arguments are that the claimed range of white pigment gives superior results as compared to the results when the amount of white pigment is outside the claimed range. There has been no showing to support this assertion with respect to the claimed composition. The examples are limited to a molding comprising 0.05 wt% of a red, yellow or orange fluorescent dye, amount 23.26 wt% barium sulfate, 0.0075 wt% or 0.0125 wt% white pigment and the rest is polymethyl methacrylate. The comparisons do not contain the white pigment. The exemplified compositions are not commensurate with respect to the scope of the claims where the amount of dye, scattering agent, the optional another colorant and plastic matrix is not taught in claims 1, 2, 4-7, 11, 13, 14 and 16 and the amount of scattering agent and plastic matrix is not taught in claim 15.

The declaration was insufficient to overcome the rejection of claims based upon JP 06-67612 as set forth in the last Office action because: the examples in the declaration are not commensurate in scope with the claims in that the composition of the examples in the declaration is limited to 1 wt% scattering agent, 0.05 wt% dye, 0, 0.0005, 0.0015, 0.0075, 0.075 or 0.15 wt% of the white pigment and the rest is polymethyl methacrylate and the statement on in section 5 that applicants know of no reason why other examples within the scope of claim 1 should not also show the same superior results indicates that the shown superior results when the amount of white pigment is within the claimed range, such as taught in the reference, which means the results are expected. Applicants argue that the Examiner has misunderstood the statement on page 5. She did not. She understands that applicants is admitting that all the compositions that fall within the scope of claim 1 would be expected give the argued superior results. The references teach a composition that contains the claimed components and amount of TiO_2 is in

the range of greater than 0 wt% to less than 10 wt%, which overlaps the claimed range. This statement means that the superior properties in the taught overlapping range of 0.001-0.1 wt% titania is not unexpected and thus the arguments do not overcome the rejection. See MPEP 2144.05 III.

Applicants argue that JP 6-67612 thinks that the all the amounts between 0.01-10 wt% give the same superior results discussed in the paragraph linking pages 1 and 2 of the specification. No where in JP 06-676612 is the difference of the color brightness between those compositions comprising scattering agents and white pigments discussed. Thus JP 6-67612 never indicates that the amounts between 0.01-10 wt% give the same superior results discussed in the paragraph linking pages 1 and 2 of the specification.

With respect to the arguments for claims 2, 6, 7 and 11, the reference clearly teaches titania as a white pigment, cast polymethyl methacrylate, another colorant and that the signs of the taught composition.

The argued upper limits in claims 13 and 14 do not overcome the rejection since the amount of titania in the reference encompasses the values of these claims.

As discussed above, the reference suggests the amount of claim 15.

With respect to claim 4, since the taught matrix is one of those claimed, it must inherently have the transmittance that falls within that of claim 4. There has been no showing that the taught cast polymethyl methacrylate does not have the a transmittance that falls within the range of claim 4.

With respect to claim 5, the Examiner stated that the taught composition would be expected to have reflectance that overlaps the claimed range since the composition overlap. There has been no showing to rebut this. The rejection is maintained.

Claim 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The claimed composition is not taught or suggested by the cited art of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorenzo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/cmk/
August 13, 2008

/C. Melissa Koslow/
Primary Examiner
Art Unit 1793